

REMARKS

By this Amendment, Applicants add claims 32-34. Thus, claims 1-6, 9-30, and 32-34 are pending. No new matter is added.

The Office Action rejects claims 1-6, 9-26, and 31 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,394,902 to Shibao. Applicants respectfully traverse the rejection.

Applicants canceled claim 31 in the December 8 Amendment After Final Rejection. Accordingly, the rejection of claim 31 is moot. Applicants respectfully request withdrawal of the rejection of claim 31.

Shibao does not disclose "an exterior shell formed by at least two tank portions assembled together, and made of molded plastics material, one of said tank portions comprising a compartment, the compartment being one-piece with the one of said tank portions" and "a fuel pump located entirely within the shell and fixed into the compartment," as recited in claim 1.

The December 28 Advisory Action alleges that "Shiabo clearly shows a fuel tank having an exterior shell (Figure 2) made of at least two tank portions 3 and 4. A pump 7 includes a pump portion in adjacent to support 6 entirely within the shell of the tank" (Page 2 of Advisory Action). Applicants respectfully traverse this assertion.

First, tank bracket 3 and main body 4 define an open exterior shell. Pump 7 is not located entirely within that shell (Figs. 1 and 2). This is evidenced by the fact that the Advisory Action only alleges that a portion of the pump 7 is located within the shell 3, 4. However, pending claim 1 clearly recites that the fuel pump, i.e., the entire pump, is located entirely within the shell, not just a portion. Accordingly, the interpretation of Shibao relied on in the Advisory Action cannot reasonably be considered to disclose "a fuel pump located entirely within the shell and fixed into the compartment," as recited in claim 1.

Because the Office Action's and Advisory Action's interpretation of Shiabo remains unclear, Applicants address two possible alternative interpretations of Shiabo below.

According to the first interpretation of Shibao, the Office Action may be alleging that main body 4 and lid member 5 are equivalent to Applicants' claimed exterior shell formed by at least two tank portions. According to this interpretation, the pump support base 6 is molded with main body 4 (col. 3, lines 37-44 and Figs 1 and 2) and presumably vertical wall 10 is molded within the main body 4 as well. Thus, either might be interpreted as a one-piece compartment since molding may result in a single structure. However, the pump 7 is exposed outside of the lid member 5 (col. 4, lines 13-17 and Fig 1) and thus cannot reasonably be considered located entirely within the shell (4, 5).

If this is the interpretation relied on by the Office Action, Shibao fails to disclose that the fuel pump is located entirely within the shell, as recited in claim 1. Accordingly, claim 1 is patentable over Shibao.

According to the second interpretation of Shibao, the Office Action may be alleging that main body 4 and lid member 5 are equivalent to Applicants' claimed compartment. Thus, the claimed exterior shell would have to be the disclosed automotive fuel tank with bottom wall 2 (see col. 2, line 63 - col. 3, line 2). Initially, Applicants note that Shibao does not disclose that the automotive fuel tank with bottom wall 2 is formed by at least two tank portions, as recited in claim 1, or that it is made by molded plastics material, as recited in claim 1. In fact, it is implicit in Shibao that the automotive fuel tank is metal since metallic bracket 3 is disclosed as welded to the bottom wall 2 of the tank (col. 4, lines 3-8). Thus, if this is the interpretation relied on by the Office Action, Shibao fails to disclose that the automotive fuel tank with bottom wall 2 is formed by at least two tank portions, as recited in claim 1, or that it is made by molded plastics material, as recited in claim 1. Accordingly claim 1 is patentable over Shibao.

Furthermore, the above-described deficiencies notwithstanding, according to the second interpretation of Shibao, the compartment (4, 5) is not one-piece with any portion of the automotive fuel tank 2. The Office Action cites a number of cases for the proposition that the term "integral" may be broadly read to include more than devices that are "one-piece" and may include constructions united by fastening and welding (see *In re Hotte*, 177 USPQ 326 (CCPA 1973); *In re Kohno*, 157 USPQ 275 (CCPA 1968); and *In re Clark*, 102 USPQ 241 (CCPA 1954) cited in the Office Action; see also, *Advanced Cardiovascular Systems, Inc. v. Scimed Life Systems, Inc.*, 887 F.2d 1070 (Fed. Cir. 1989) and *Henderson v. Grable*, 339 F.2d 465 (CCPA 1964)). However, the Office Action and Advisory Action then incorrectly deduces the reverse, i.e., that anything "integral" may be considered "one-piece" (see Office Action, page 3, lines 9-13 and Advisory Action, page 2). It is clear from the above-cited cases, including the portions relied on by the Office Action and Advisory Action, that "one-piece" is a sub-set of the larger category "integral." Thus, the term "integral" may include both devices that are truly "one-piece" and devices that are, for example, "united by fastening and welding," but not one-piece. None of the above cited cases may be relied on for the proposition that the term "one-piece" includes devices that are integral due to, for example, being "united by fastening and welding." In fact, the cases specifically recognize that "one-piece" is separate and distinct from the devices that may be considered integral by virtue of being, for example, "united by fastening and welding" (see, e.g., *Advanced*, 877 F.2d at 1072).

Because, according to the second interpretation of Shibao, the compartment (4, 5) is fastened to the automotive fuel tank 2 using external flange 4a and tank bracket 3 (col. 3, lines 3-18), the compartment (4, 5) cannot reasonably be considered one-piece with the tank 2. This is further evidenced by the fact that the compartment (4, 5) and flange 4a are made from polyacetal resin and the tank bracket 3 and tank 2 are made of metal (col. 3, lines 3-18).

In the only alternative construction discussed in Shibao, the compartment (4, 5) may be removably connected to the tank 2 using an engagement piece and engagement claw structure (col. 4, lines 48-60). However, because according to this construction the compartment (4, 5) is removably connected to the tank 2, the compartment (4, 5) cannot reasonably be considered one-piece with the tank 2.

Accordingly, if the Office Action is relying on the second interpretation of Shibao, Shibao fails to disclose "an exterior shell formed by at least two tank portions assembled together, and made of molded plastics material, one of said tank portions comprising a compartment, the compartment being one-piece with the one of said tank portions, " as recited in claim 1. Accordingly claim 1 is patentable over Shibao.

In view of at least the foregoing, claim 1 is patentable over Shibao. Further, Applicants respectfully submit that claims 2-6 and 9-26 are patentable at least in view of the patentability of claim 1, from which they depend, as well as for the additional features they recite. Applicants respectfully request withdrawal of the rejection of claims 1-6 and 9-26.

The Office Action rejects claims 27-30 under 35 U.S.C. § 103(a) over U.S. Patent 5,394,902 to Shibao. Applicants respectfully traverse the rejection.

As discussed above with respect to claim 1, Shibao does not disclose "an exterior shell formed by at least two tank portions assembled together, and made of molded plastics material, one of said tank portions comprising a compartment, the compartment being one-piece with the one of said tank portions" and "a fuel pump located entirely within the shell and fixed into the compartment," as recited in claim 27. Applicants note that Shibao does not teach or suggest these features of claim 27. In fact, Shibao specifically discloses features that directly contradict the features of claim 27 (i.e., providing a lid member 5 specifically designed to allow part of the fuel pump to be exposed outside the shell (first interpretation) or

connecting the compartment (4, 5) to the tank 2 such that it is not one-piece (second interpretation).

Because Shibao does not disclose, teach, or suggest all of the features of claim 27, claim 27 is patentable over Shibao. Applicants also respectfully submit that claims 28-30 are patentable at least in view of the patentability of claim 27, from which they depend, as well as for the additional features they recite. Applicants respectfully request withdrawal of the rejection of claims 27-30.

By this Amendment, Applicants add claims 32-34. Support for claims 32-34 may be found at least on page 3, lines 20-32, page 4, lines 1-3, in Figs. 1-4, and in original claims 1 and 6. Claims 32 and 34 recite that the compartment is monolithic with the lower tank portion. Thus, claims 32 and 34 require that the compartment and lower tank portion be monolithic, i.e., a single uniform whole (American Heritage College Dictionary 3ed. 882). As discussed above, Shibao does not disclose this feature of claims 32 and 34. Furthermore, even if the above-cited case law could be interpreted for the proposition that anything "integral" may be considered "one-piece" (which Applicants traverse), they may not be read for the proposition that anything integral may be considered monolithic.

Furthermore, with respect to claims 32 and 34, Shibao does not disclose that the monolithic compartment is placed at a low point of the tank, the upper tank portion includes a filler tube having an end positioned in such a manner that, during filling, the fuel drops from the filler tube into the monolithic compartment.

Shibao discloses that "inlet opening 8 is provided in a lower part of the main body 4 adjacent to the engagement piece 4b and serves as a substantially sole channel of fuel communication in and out of the fuel pump inlet chamber defined inside main body 4" (col. 3, lines 54-58). Inlet opening 8 cannot reasonably be considered equivalent to the claimed filler

tube in the upper tank portion since inlet opening 8 is in main body 4, which includes the fuel pump (i.e., lower tank portion according to claim 32).

Finally, Shibao does not disclose that "the shape of the monolithically molded compartment is configured such that, when a remainder of the tank is empty, an amount of fuel may remain within the monolithically molded compartment sufficient to prime the fuel pump, as recited in claim 33. In fact, because fuel is drawn from the inlet opening 8 into fuel pump inlet chamber of main body 4, the inlet chamber will be emptied just prior to the remainder of the tank because the inlet opening 8 is above the bottom surface of the tank 2 (col. 3, line 37-col. 4, line 41, Fig 1).

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of claims 1-6, 9-30, and 32-34.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



William P. Berridge
Registration No. 30,024

Jesse O. Collier
Registration No. 53,839

WPB:JOC/tea

Date: January 10, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

| |
|--|
| <p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p> |
|--|